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a transmitting device for transmitting the image information and the print information to an external apparatus.

REMARKS

By this Amendment, Applicants have amended claim 1. Claims 1-13, 17-21, and 28 are pending in this application, with claim 1 being only independent claim.

In the Office Action, the Examiner rejected claims 1-3 and 6-13 under 35 U.S.C. § 102(e) as being anticipated by Moghadam et al. (U.S. Patent No. 5,917,542); rejected claims 4, 5, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Moghadam et al. in view of Saegusa (U.S. Patent No. 5,799,217); rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Moghadam et al. in view of Friend et al. (Understanding Data Communications); rejected claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Moghadam et al. in view of Kaihatsu (U.S. Patent No. 5,898,386); rejected claims 1-3 and 6-13 under 35 U.S.C. § 103(a) as being unpatentable over Hull et al. (U.S. Patent No. 5,806,005) in view of Inoue et al. (U.S. Patent No. 4,728,978); rejected claims 4, 5, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Hull et al. in view of Inoue et al. and further in view of Saegusa; rejected claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Hull et al. in view of Inoue et al. and further in view of Friend et al.; and rejected claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Hull et al. in view of Inoue et al. and further in view of Kaihatsu.

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First of all, Applicants respectfully request that the Examiner clarify the status of claim 28. Neither the Office Action Summary nor the body of the Office Action indicates the status of claim 28 added by the Amendment filed on June 13, 2002. To make the record clear, Applicants respectfully request that the Examiner clarify the status of claim 28 in the next communication.

Applicants respectfully traverse the rejection under 35 U.S.C. §102(e) because Moghadam et al. fails to disclose all of the elements recited in the claims. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(e), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131 (8th ed. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

For example, Moghadam et al. fails to disclose a camera including, among other things, "a print information producing device for producing print information for printing the image information, the print information including print designating information which designates an image to be printed among the plural different images," as recited in independent claim 1. As shown in Fig. 1, Moghadam et al. discloses a digital camera 22 including a short term memory 36 and a long term memory 44. Moghadam et al. discloses that "the digital camera 22 is controlled by a micro processor 34 which receives the digital image signal and stores it temporarily in short term memory 36."

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Col. 2, lines 59-61. Moghadam et al. further discloses that "a long term memory 44 . . . is connected to microprocessor 34 for longer storage of digital image files." Col. 3, lines 13-17. However, neither the short term memory 36 nor the long term memory 44 of the device disclosed in Moghadam et al. is "a print information producing device for producing print information for printing the image information, the print information including print designating information which designates an image to be printed among the plural different images," as recited in independent claim 1. For at least this reason, Moghadam et al. fails to anticipate independent claim 1.

Applicants also respectfully traverse the rejection under 35 U.S.C. §103(a) because the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

For example, Hull et al. and Inoue et al., even when combined, fail to disclose or suggest a camera including, among other things, "a print information producing device for producing print information for printing the image information, the print information

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including print designating information which designates an image to be printed among the plural different images,” as recited in independent claim 1.

Applicants respectfully request that the Examiner clarify the structure of Hull et al. that the Examiner is interpreting as “a print information producing device for producing print information for printing the image information.” The Examiner alleged that “Hull teaches the salient features of the claimed invention including a digital camera with a CCD 20 and means for transmitting print information 28.” Office Action, page 4. The Examiner further alleged that “Hull does not teach that the print information includes number of prints or which prints to print.” *Id.* Based on these statements, the Examiner apparently alleged that Hull et al. discloses or suggests “a print information producing device for producing print information for printing the image information.” The Examiner, however, did not identify any structure disclosed in Hull et al. which constitutes the recited “print information producing device for producing print information for printing the image information.” Accordingly, Applicants respectfully request that the Examiner clarify this point in the next communication.

Contrary to the Examiner’s apparent allegation, Hull et al. fails to disclose or suggest any “print information producing device for producing print information for printing the image information.” As shown in Fig. 1, Hull et al. discloses an image transfer system 10 with a remote station 12 coupled to a server station 14 via a cellular telephone system 16. Hull et al. further discloses several applications of the image transfer system 10, including collection of vacation photos, television reporting, in-field stereo image capture, obtaining photocopies in locations, such as libraries, where it is

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not convenient to bring the item to be copied to a photocopy machine, and stereoscopic matching. However, Hull et al. fails to disclose or suggest any “print information producing device for producing print information for printing the image information,” let alone “a print information producing device for producing print information for printing the image information, the print information including print designating information which designates an image to be printed among the plural different images.”

Inoue et al. fails to make up for the shortcomings of Hull et al. even if the Examiner’s characterization of Inoue et al. is accurate. According to the Examiner, Inoue et al. teaches that “it was known for the user to include the number prints information from the camera.” Office Action, page 4. Applicants do not agree with this characterization of Inoue et al. However, even if this characterization were accurate, Inoue et al. would still fail to make up for the deficiencies of Hull et al., which omits any disclosure or suggestion of “a print information producing device for producing print information for printing the image information.”

Furthermore, Inoue et al. fails to disclose or suggest “the print information including print designating information which designates an image to be printed among the plural different images,” as recited in independent claim 1. Inoue et al. discloses that “the data to be communicated between the camera and the IC card comprise photographic information and/or development information.” Col. 2, lines 3-6. Inoue et al. further discloses that the development information includes “at least one of the following[]: trimming information, the color temperature information, information concerning a film size, a frame number of the film, a number of prints, a size of print,

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necessities of high speed development, producing a slide(s) and of special treatment, information concerning the date and the time." Col. 2, lines 19-25. Inoue et al., however, fails to disclose or suggest that the development information includes "print designating information which designates an image to be printed among the plural different images."

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness regarding independent claim 1 at least because Hull et al. and Inoue et al., even when combined, fail to disclose or suggest each and every element recited in this claim. Moreover, the other cited references fail to make up for this deficiency in Hull et al. and Inoue et al.

For at least the foregoing reasons, Applicants respectfully submit that independent claim 1 is in condition for allowance. Claims 2-13, 17-21, and 28 are also in condition for allowance at least by virtue of their dependency from allowable independent claim 1.

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Attached hereto is a marked-up version of the changes made to a claim by this Amendment. The attachment is captioned "**APPENDIX TO AMENDMENT OF DECEMBER 12, 2002.**" Deletions appear as normal text surrounded by [] and additions appear as underlined text.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: December 12, 2002

By: 

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APPENDIX TO AMENDMENT OF DECEMBER 12, 2002

IN THE CLAIMS:

1. (Four Times Amended) A camera comprising:

an image-pickup device for receiving light to form an image of a subject, for converting the light into electric signals representing the image, and for producing image information of [the image of the subject by the electric signals] plural different images of plural different subjects by electric signals;

a print information producing device for producing print information for printing the image information, the print information including print designating information which designates an image to be printed among the plural different images; and

a transmitting device for transmitting the image information and the print information to an external apparatus.

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